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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,914	06/28/2001	Dina Katsir	216-028B	5885
7590	03/25/2004		EXAMINER STEIN, STEPHEN J	
James V. Costigan, Esq. HEDMAN, GIBSON & COSTIGAN, P.C. Suite 2003 1185 Avenue of the Americas New York, NY 10036-2646			ART UNIT 1775	
DATE MAILED: 03/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/893,914

**Applicant(s)**

KATSIR ET AL.

**Examiner**

Stephen J Stein

**Art Unit**

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-33 is/are allowed.
- 6) ☒ Claim(s) 34-36 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. Claims 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,851,870 (Alugbin et al).

Alugbin discloses a capacitor comprising a conductive substrate and a patterned dielectric which exposes the substrate (See col. 2, lines 20-27). Alugbin further teaches that the patterned dielectric is SiO<sub>2</sub> (oxide of a valve metal) and the substrate is made of conductive polysilicon (both the substrate and dielectric are made of the same valve metal) (See col. 6, lines 6-48). With regard to the process limitations recited in claims 34-35, process limitations in product claims are generally not dispositive on patentability unless it is shown that the process limitations produce a materially different product. MPEP §2113.

### ***Allowable Subject Matter***

2. Claims 29-33 are allowed over the prior art of record.
3. Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 29-33, while the closest prior art of record, Popp, teaches an electrolytic capacitor comprising an electrode of an aluminum metal anode foil (electrically conductive valve metal substrate) and a dielectric layer of aluminum oxide (valve metal oxide) formed on the aluminum anode foil and further teaches that the electrode has a fractal surface

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coating, the Popp reference fails to teach that or suggest that that the fractal surface coating includes both a valve metal and a metal oxide thereof.

Regarding claim 37, as stated above, while the closest prior art of record, (Alugbin), discloses a capacitor comprising a polysilicon conductive substrate and a patterned (discontinuous) SiO<sub>2</sub> dielectric which exposes the substrate, the prior art fails to teach that the valve metal oxide is aluminum oxide.

### ***Response to Arguments***

5. Applicants' arguments in their appeal brief have been carefully considered and have been deemed persuasive. The rejections of claims 29-37 over the Popp reference and the Popp reference in view of Allegret reference have been withdrawn. New rejections have been made over the Alugbin reference.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is 572-272-1544. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

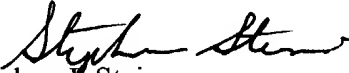
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 21, 2004

  
Stephen J. Stein  
Primary Examiner  
Art Unit 1775